

## REMARKS

This Response is submitted in response to the Office Action in the above-identified case mailed February 4, 2003, and to the personal interview courteously granted to Applicants' representatives on March 11, 2003. Claims 1 to 31 were previously pending. In this Response, Claims 1, 6 to 9, 13 to 16 and 20 to 30 are being amended. The specification is being amended in various places for minor grammatical reasons. No new matter is being introduced by way of any of the amendments or additions. A Supplemental Information Disclosure Statement is submitted herewith. An Affidavit of Darren Maya under 37 C.F.R. § 1.131 is also submitted herewith. A check in the amount of \$180.00 is submitted herewith to cover the cost of the Supplemental Information Disclosure Statement. Please charge Deposit Account No. 02-1818 for any fees that are deemed necessary.

As an initial manner, the Office action indicated that Claims 9 to 31 should be withdrawn from consideration; however, as discussed during the interview, it is respectfully submitted that Claim 30 is generic to the embodiments of the other claims and that Claims 1 to 31 must be considered. The Examiner stated in Interview Summary that further consideration will be given to the restricted generic claims.

In the Office Action, Claims 1 to 8 were rejected under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 4,978,129 to Komeda et al. ("*Komeda*") and U.S. Patent No. 4,695,053 to Vasquez, Jr. et al. ("*Vasquez*"). During the personal interview, Applicants' representatives explained the difference between the present invention and the combination of *Vasquez* and *Komeda*. Applicants' representatives pointed to the fact that *Vasquez* does not modify digits of an existing or original award. Rather, *Vasquez* teaches a matching-type game, wherein the gaming device pays the player based on how many numbers selected by the player are thereafter a randomly displayed on slot machine reels. For example, *Vasquez* at col. 5, line 44 begins a discussion of numbers appearing on reels 12, 14 and 16 that are compared with the player's selected numbers. *Vasquez* describes that if fewer than all three player selected numbers match numbers on the reels, the gaming device pays a win from the hopper. If all three of the player selected numbers are displayed on the reels, the game

goes into a handpay mode, wherein the gaming device signals a casino operator to come and pay the player.

The disclosure of *Vasquez* does not teach or suggest presenting an award to the player that has a plurality of digits, modifying the digits so that a modified or visually different award appears and then providing the modified award to the player. As described in more detail below, Applicants believe that the amended claims are patentably distinguished over *Vasquez*.

*Komeda* does not remedy the deficiencies of *Vasquez*. *Komeda* describes a game that is played on a calculator. Notwithstanding the fact that the *Komeda* reference describes an apparatus that is non-analogous to the gaming device of the present invention, *Komeda* does not teach or suggest the present invention and does not make up for the deficiencies of *Vasquez*. *Komeda* describes instead an electronic game in which the player manually shifts digits of a number left and right and/or exchanges digits with the hope of converting a set of numbers into a final form (see, e.g., col. 5, line 24). The *Komeda* game is more akin to a puzzle or skill game than the random gaming device of the present invention. *Komeda* does not teach an award for the player, randomly generating an original award or randomly modifying the original award to provide a modified award for the player. In short, one would not look to the manually operated skill game of *Komeda* in view of *Vasquez* in order to create the gaming device of the present invention as claimed.

As discussed in the interview, Applicants believe that the claims as filed can be amended to more clearly define the present invention over *Komeda* and *Vasquez*. In particular, Applicants suggested that the claims reflect the fact that the original award is in response to a gaming event. That is, the present invention covers a game that generates an award for the player, modifies the award and then provides the modified award to the player.

Each of the independent claims has accordingly been amended to clarify that the original award results from a gaming event played by a player, and wherein the digits indicate an amount of the original award. Further, each of the independent claims has been amended to clarify that the modified digits indicate an amount of a new award for the player.

Applicants respectfully submit that the above-described elements sufficiently clarify the present invention over *Vasquez* and *Komeda*. Accordingly, Applicants respectfully submit that amended independent Claims 1, 9, 16, 23, 29 and 30 and dependent Claims 2 to 8, 10 to 15, 17 to 22, 24 to 28 and 31 that depend respectively from those amended independent claims are each patentable and allowable over *Komeda* and *Vasquez*. It should be appreciated that various ones of the dependent claims have been amended to be in accordance with the independent claims as amended. Applicants believe that the amendments to those dependent claims are non-narrowing and do not disclaim any additional subject matter.

It is also respectfully submitted that if the application submitted in the Supplemental Information Disclosure Statement and published as Pub. No. US 2003/0027623 A1 is deemed relevant, the present invention was conceived prior to the filing date of July 25, 2001 of that application as demonstrated by the accompanying Affidavit of Darren Maya. The Affidavit demonstrates that art work was being prepared for a commercial embodiment of the present invention at least as early as May 8, 2001. The conception date of the present invention is thus sometime prior to May 8, 2001.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the Applicants' attorney, Adam Masia, at (312) 807-4284 to discuss this Response.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current response. The attached page is captioned "**Version with Markings to Show Changes Made.**"

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY Adam H. Masia

Adam H. Masia  
Reg. No. 35,602  
P.O. Box 1135  
Chicago, Illinois 60690-1135  
Phone: (312) 807-4284

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Specification:**

The paragraph beginning at page 1, line 8 has been amended as follows:

The present invention relates to the following co-pending commonly owned U.S. patent applications: "Gaming Device Having Apparatus and Method for Producing an Award Through Award Elimination or Replacement," filed on October 11, 2000, Serial No. 09/686,283, Attorney Docket No. 0112300-139; "Gaming Device Having Award Exchange Bonus Round And Method For Revealing Award Exchange Possibilities," Serial No. 09/689,510, Attorney Docket, No. 0112300-140; "Gaming Device Having Graduating Award Exchange Sequence With A Tease Consolation Sequence And An Initial Qualifying Sequence," Serial No. 09/680,601, Attorney Docket No. 0112300-142; "Gaming Device Having Value Selection Bonus," filed on October 6, 2000, Serial No. 09/684,605, Attorney Docket No. 0112300-156; and "Gaming Device Having Player Selectable Award Digits And Award Modification Option," Serial No. 09/934,003, Attorney Docket No. 0112300-722.

The paragraph beginning at page 16, line 6 has been amended as follows:

Referring now to Figs. 3A and 3B, the game displays three selectable selections or masked numbers 116, namely, the "X," "Y" and "Z" selections or masked numbers 116. The selections or masked numbers 116 illustrated generally on the screen ~~400~~ 130, as well as other inputs and indicators, preferably contain indicia that relate to a theme of the gaming device. The selections or masked numbers 116 hide numbers or digits that are revealed and become part of the player's award. That is, the player's award is based on the order of numbers or digits associated with the selections or revealed when the masked numbers are unmasked. For purposes of this application, "selections" and "masked numbers" are used interchangeably.

The paragraph beginning at page 26, line 17 has been amended as follows:

The weighting distribution is different for the tens digit 120, as illustrated by the database 146. Here, the middle values 4 through 6 are generated slightly more often than the lower or higher values. The higher values of 7, 8 and 9 each have a ten percent chance of being generated, while the lower values each have a less than ten percent likelihood of being generated. For the one's digit 122, the database 148 weights the values 0 through 9 such that the highest values are most likely to be generated, the ~~middles-vales~~ middle values are the second most and lowest values the least most likely to be generated.

The paragraph beginning at page 27, line 23 has been amended as follows:

The screen ~~100~~ 145 can present any number of selectable inputs, such as inputs 102 through 108, and is not limited to presenting four as illustrated. The selectable inputs in one embodiment are areas of a touch screen 50 (see Fig. 2) in communication with the processor 38 and a touch screen controller 52. The inputs may alternatively be separate electromechanical input devices, mounted elsewhere on gaming device 10, which are in communication with the processor 38. A message 110 is visually displayed, audibly displayed through speakers 36 or both.

The paragraph beginning at page 29, line 22 has been amended as follows:

The game as illustrated in Figs. 3A through 6 does not resemble the known primary games of slot poker, keno or blackjack. Indeed, the embodiments illustrated to this point are preferably a bonus game which can be triggered by any of the above mentioned primary games or any other primary game. The bonus game preferably includes indicia and a theme in accordance with a theme of the base game. In one implementation, the theme of the game includes a mother ~~kangaroos~~ kangaroo and baby kangaroos or joeys.

The paragraph beginning at page 36, line 7 has been amended as follows:

Since the different methods have substantially different potential outcomes, the ~~method~~ generation of the methods is preferably weighted, although it does not have to be. Generally, the more drastically the original award may change due to a modification method, the less likely it is that the game generates that modification method.

**In the Claims:**

Claim 1 has been amended as follows:

1. (Amended) A gaming device comprising:  
a display device;  
an original award having a plurality of digits displayed by the display device, said original award resulting from a gaming event played by a player and wherein the digits indicate an amount of the original award; and  
a processor which communicates with the display device, which rearranges the digits of the original award, which causes the display device to display said rearranged award digits and which provides the rearranged a modified award to a player wherein the rearranged digits indicate the amount of the modified award.

Claim 6 has been amended as follows:

6. (Amended) The gaming device of Claim 1, which wherein the gaming event includes a plurality of player selectable positions displayed by the display device, wherein the processor enables the player to select the positions, associates digits with the player's selection of the positions and determines the original award based on an order of the digits associated with the positions.

Claim 7 has been amended as follows:

7. (Amended) The gaming device of Claim 1, ~~which~~wherein the gaming event includes a plurality of masked digits displayed by the display device, wherein the processor enables the player to arrange at least two of the masked digits in an order, and the original award is based on the order of the masked digits arranged by the player.

Claim 8 has been amended as follows:

8. (Amended) The gaming device of Claim 1, ~~which~~wherein the gaming event includes a plurality of selections displayed by the display device, wherein the processor associates digits with said selections, and which enables a player to associate selections with a one's digit, a ten's digit and a hundred's digit of the original award provided to the player.

Claim 9 has been amended as follows:

9. (Amended) A gaming device comprising:  
a display device;  
an original award having a plurality of digits displayed by the display device, said original award resulting from a gaming event played by a player and wherein the digits indicate an amount of the original award; and  
a processor which communicates with the display device, which adds a new digit to the digits of the original award, displays a new award including said new digit and provides the new award to a player, wherein the digits of the original award and the new digit indicate the amount of the new award.

Claim 13 has been amended as follows:

13. (Amended) The gaming device of Claim 9, ~~which~~wherein the gaming event includes a plurality of player selectable positions displayed by the display device, wherein the processor enables the player to select the positions, associates digits with the player's selection of the positions and which determines the original award based on an order of the digits associated with the positions.



Claim 14 has been amended as follows:

14. (Amended) The gaming device of Claim 9, ~~which~~wherein the gaming event includes a plurality of masked digits displayed by the display device, wherein the processor enables the player to arrange at least two of the masked digits in an order, and the original award is based on the order of the masked digits arranged by the player.

Claim 15 has been amended as follows:

15. (Amended) The gaming device of Claim 9, ~~which~~wherein the gaming event includes a plurality of selections displayed by the display device, wherein the processor associates digits with said selections, and which enables a player to associate selections with a one's digit, a ten's digit and a hundred's digit of the original award provided to the player.

Claim 16 has been amended as follows:

16. (Amended) A gaming device comprising:  
a display device;  
an original award having a plurality of digits displayed by the display device, said original award resulting from a gaming event played by a player and wherein the digits indicate an amount of the original award; and  
a processor which communicates with the display device, which removes a digit from the digits of the original award, displays a new award without the removed digit and provides the new award to a player, wherein the digits of the original award with the digit removed indicate the amount of the new award.

Claim 20 has been amended as follows:

20. (Amended) The gaming device of Claim 16, ~~which~~wherein the gaming event includes a plurality of player selectable positions displayed by the display device, wherein the processor enables the player to select the positions, associates digits with the player's selection of the positions and determines the original award based on an order of the digits associated with the positions.

Claim 21 has been amended as follows:

21. (Amended) The gaming device of Claim 16, ~~which~~ wherein the gaming event includes a plurality of masked digits displayed by the display device, wherein the processor enables the player to arrange at least two of the masked digits in an order, and the original award is based on the order of the masked digits arranged by the player.

Claim 22 has been amended as follows:

22. (Amended) The gaming device of Claim 16, ~~which~~ wherein the gaming event includes a plurality of selections displayed by the display device, wherein the processor associates digits with said selections, and which enables a player to associate selections with a one's digit, a ten's digit and a hundred's digit of the original award provided to the player.

Claim 23 has been amended as follows:

23. (Amended) A gaming device comprising:  
a display device;  
a processor that communicates with the display device;  
an original award including a plurality of digits displayed by the display device, said original award resulting from a gaming event played by a player and wherein the digits indicate an amount of the original award;  
a plurality of different award modification methods which are adapted to modify at least one of the digits of the original award; and  
a player selectable modify input which communicates with the processor, an activation of which initiates one of the award modification methods selected from the plurality of award modification methods.

Claim 24 has been amended as follows:

24. (Amended) The gaming device of Claim 23, wherein the award modification method includes a rearrangement of the digits of the original award, wherein the rearranged digits indicate an amount of a modified award.

Claim 25 has been amended as follows:

25. (Amended) The gaming device of Claim 23, wherein the award modification method includes an award regeneration from numbers used to form the original award, wherein the regenerated numbers indicate an amount of a modified award.

Claim 26 has been amended as follows:

26. (Amended) The gaming device of Claim 23, wherein the award modification method includes adding a digit to the original award, wherein the digits of the original award and the new digit indicate an amount of a modified award.

Claim 27 has been amended as follows:

27. (Amended) The gaming device of Claim 23, wherein the award modification method includes ~~subtracting~~ removing a digit from the original award, wherein the digits of the original award with the digit removed indicate an amount of a modified award.

Claim 28 has been amended as follows:

28. (Amended) The gaming device of Claim 23, wherein the award modification method includes multiplying the original award by a number, wherein a product of the multiplication results in a modified award.

Claim 29 has been amended as follows:

29. (Amended) A gaming device comprising:

a display device;

an original award including a plurality of digits displayed by the display device, said original award resulting from a gaming event played by a player and wherein the digits indicate an amount of the original award;

a plurality of different award modification methods which are adapted to modify at least one of the digits of the original award; and

a processor that communicates with the display device and randomly initiates one of the modification methods selected from the plurality of modification methods.

Claim 30 has been amended as follows:

30. (Amended) A gaming device comprising:

a display device;

an original award represented by a plurality of individual digits displayed by the display device, said original award resulting from a gaming event played by a player and wherein the digits indicate an amount of the original award; and

a final award provided to a player, said final award including a modification of the digits of the original award displayed by the display device, wherein the modified digits of the original award indicate an amount of the final award and wherein the modification of the original award is selected from the group consisting of: a rearrangement of at least two of the digits of the original award, an addition of a digit to the digits of the original award, a removal of one of the digits of the original award, and a modification of at least one of the digits of the original award.